

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

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|--------------|----------------------|-------------|-----------------|
| Applicant : | William Allen et al. | Art Unit : | 2635 |
| Serial No. : | 10/752,391 | Examiner : | Vernal U. Brown |
| Filed : | January 6, 2004 | Conf. No. : | 3571 |
| Title : | REMOTE CONTROLLING | | |

Mail Stop Appeal Brief - Patents

Hon. Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

AMENDED APPEAL BRIEF

(i) *Real Party in Interest.*

Bose Corporation.

(ii) *Related Appeals and Interferences.*

None.

(iii) *Status of Claims.*

Claims 1-8 and 12-14, and apparently claims 15 and 16, stand rejected under 35 U.S.C. §102(b) as being anticipated by Van Ee. Claim 11 stands rejected under 35 U.S.C. §103(a) as being unpatentable over Van Ee as a primary reference and Sassas as a secondary references. Claims 17, 19 and 20 stand rejected under 35 U.S.C. § 103(a) as anticipated by Christiansen. Claim 18 stands rejected under 35 U.S.C. § 103(a) as unpatentable over Christensen in view of Kamienicki.

(iv) *Status of Amendments.*

An amendment filed subsequent to final action canceling claims 17-20 was considered but not entered. Claims 17-20 are not pursued on this appeal.

(v) *Summary of Claimed Subject Matter.*

1. A method comprising providing, to a user of a control device, such as remote controller 50, an indication of a value currently representative of a preset sound signal source, page 4, lines 12-13, and simultaneously providing an indication of a possible new value of the preset representative of a different sound signal source. Page 4, lines 13-14.

9. A method comprising enabling a user of a control device, such as remote controller 50, to indicate a possible new value of a preset sound signal source and to separately confirm the indication, and while the new value has been indicated and before the indication has been confirmed, changing an operation of another device in accordance with the indicated possible new value. Page 4, lines 5-15.

13. A method comprising providing to a user of a control device, such as remote controller 50, an indication of values of recently invoked presets, each of the preset values being representative of a sound signal source of works to be performed on an electronic device, different ones of the preset values being associated with different sources. Page 5, line 24 - Page 6, line 7.

15. A method comprising displaying values of possible selections of sound signal sources at one level of a hierarchy of values, enabling a user to select one of the values at the one level of the hierarchy, and while at least a portion of the one level of the hierarchy is displayed, showing possible selections at a second, lower level of the hierarchy that correspond to the one of the values selected by the user, at least another portion of the one level being obscured. Page 10, line 29 - Page 13, line 4.

(vi) Grounds of Rejection to be Reviewed on Appeal.

1. Whether claims 1-8 and 12-16 are anticipated by Van Ee when the reference fails to disclose each and every limitation in these claims arranged as in the claims.

2. Whether claim 11 meets the condition for patentability under 35 U.S.C. §103(a) when the Van Ee primary reference and SASAS secondary reference fail to suggest the desirability of combining what is there disclosed to meet the limitations in these claims.

(vii) *Argument.*

- I. VAN EE FAILS TO ANTICIPATE CLAIMS 1-8 AND 12-14 AT LEAST BECAUSE THE REFERENCE FAILS TO DISCLOSE SIMULTANEOUSLY PROVIDING AN INDICATION OF A POSSIBLE NEW VALUE OF THE PRESET REPRESENTATIVE OF A DIFFERENT SOUND SIGNAL SOURCE OR EACH PRESET VALUE BEING REPRESENTATIVE OF A SOUND SIGNAL SOURCE OF WORKS TO BE PERFORMED ON AN ELECTRONIC DEVICE.

The final action states:

Claims 1-8, 12-1[6] are rejected under 35 U.S.C. 102(b) as being anticipated by Van Ee et al. US Patent 6208341. Regarding claims 1, 6, and 13, Van Ee et al. teaches a method comprising providing, to a user of a control device, an indication of a value currently associated with a preset sound source (time delay between macros as shown in figure 5), and simultaneously providing an indication of a possible new value representative of a different sound source (eg. TV, VCR) of the preset by showing the sign to increment or decrement the delay time (col. 4 lines 8-18).

Regarding claims 2-3, Van Ee et al. teaches the preset is associated with works performed by a multi-media system (col. 4 lines 8-18).

Regarding claim 4, Van Ee et al. teaches the indications comprise graphical items on a display (col. 2 lines 15-19).

Regarding claim 5, Van Ee et al. teaches the display 202 is part of the control device (figure 2).

Regarding claims 7-8, Van Ee et al. teaches the control device communicates with a second device to effect the confirmed new preset value by transmitting the IR signal according to the preset delay value (col. 4 lines 8-18).

Regarding claim 12, Van Ee et al. teaches a method comprises a source of items to be performed (controlling the home theater), the source being configured to store the items for performance (control codes) in response to the preset (col. 3 lines 53-58).

Regarding claim 9, Van Ee et al. teaches enabling a user of a control device to indicate a possible new value of a preset (time delay between macros as shown in figure 5) (col. 4 lines 8-18) and to separately confirm the indication by selecting the delay using the arrow keys (col. 4 lines 15-25). Van Ee et al. further teaches using the new value to effect other device such as the TV, VCR and audio system (col. 4 lines 8-18).

Regarding claim 10, Van Ee et al. teaches the value comprises identifier of a station (TV- 3) (col. 4 line 11). Regarding claims 15-16, Van Ee et al. teaches a method comprising displaying values of possible selections at one level of a hierarchy of values, enabling a user to select one of the values at the one level of the hierarchy (col. 2 lines 5-6), and while at least a portion of the one level of the hierarchy is displayed, showing possible selections at a second, lower level of the hierarchy that correspond to the one of the values selected by the user, at least another portion of the one level being obscured (col. 2 lines 5-19). Pp. 2-4.

* * *

Regarding Applicant's argument on page 14 that the values are representative of a sound signal source, the reference of Van Ee et al. teaches the delay values are associated with sound signal source (col. 2 line 55-col. 3 line 15). P. 2.

The response to the request for reconsideration mailed July 19, 2006 states:

Regarding applicant argument regarding indication of the value currently representative of a preset sound signal source, the reference of Van Ee et al. teaches enabling a user to view macros for controlling sound signal sources (col. 2 lines 20-40). Van Ee et al. teaches values representative of the audio source such as the channel the TV is tune to (col. 4 lines 10-15) and the delay time showing the time given for user intervention during the execution of the macro (col. 3 lines 8-13). The presets of the audio source as disclosed by Van Ee et al. is consistent with the applicant description of the preset on page 4, which include the channel selection and other control options. Van Ee et al. also teaches an indication of a possible new value representative of a different sound source (eg. TV, VCR) of the preset by showing the sign to increment or decrement the delay time (col. 4 lines 8-18). Pp. 1-2.

This ground of rejection is respectfully traversed. Claim 1 and the claims dependent thereon call for "simultaneously providing an indication of a possible new value of the preset representative of a different sound signal source", and Claims 13 and 14 call for "each of the preset values being representative of a sound signal source of works to be performed on an electronic device..." These limitations are different from "delay values [that] are associated with sound signal source..."

"It is well settled that anticipation under 35 U.S.C. 102 requires the presence in a single reference of all of the elements of a claimed invention." *Ex parte Chopra*, 229 U.S.P.Q. 230, 231 (BPA&I 1985) and cases cited.

"Anticipation requires the presence in a single prior art disclosure of all elements of a claimed invention arranged as in the claim." *Connell v. Sears, Roebuck & Co.*, 220 U.S.P.Q. 193, 198 (Fed. Cir. 1983).

"This court has repeatedly stated that the defense of lack of novelty (i.e., 'anticipation') can only be established by a single prior art reference which discloses each and every element of the claimed invention." *Structural Rubber Prod. Co. v. Park Rubber Co.*, 223 U.S.P.Q. 1264, 1270 (Fed. Cir. 1984), citing five prior Federal Circuit decisions since 1983 including *Connell*.

In a later analogous case the Court of Appeals for the Federal Circuit again applied this rule in reversing a denial of a motion for judgment n.o.v. after a jury finding that claims were anticipated. *Jamesbury Corp. v. Litton Industrial Prod., Inc.*, 225 U.S.P.Q. 253 (Fed. Cir. 1985).

After quoting from *Connell*, "Anticipation requires the presence in a single prior art disclosure of all elements of a claimed invention arranged as in the claim," 225 U.S.P.Q. at 256, the court observed that the patentee accomplished a constant tight contact in a ball valve by a lip on the seal or ring which interferes with the placement of the ball. The lip protruded into the area where the ball will be placed and was thus deflected after the ball was assembled into the valve. Because of this constant pressure, the patented valve was described as providing a particularly good seal when regulating a low pressure stream. The court quoted with approval from a 1967 Court of Claims decision adopting the opinion of then Commissioner and later Judge Donald E. Lane:

[T]he term "engaging the ball" recited in claims 7 and 8 means that the lip contacts the ball with sufficient force to provide a fluid tight seal. *** The Saunders flange or lip only sealingly engages the ball 1 on the upstream side when the fluid pressure forces the lip against the ball and never sealingly engages the ball on the downstream side because there is no fluid pressure there to force the lip against the ball. The Saunders sealing ring provides a compression type of seal which depends upon the ball pressing into the material of the ring. *** The seal of Saunders depends primarily on the contact between the ball and the body of the sealing ring, and the flange or lip sealingly contacts the ball on the upstream side when the fluid pressure increases. 225 U.S.P.Q. at 258.

Relying on *Jamesbury*, the ITC said, "Anticipation requires looking at a reference, and comparing the disclosure of the reference with the claims of the patent in suit. A claimed device is anticipated if a single prior art reference discloses all the elements of the claimed invention as arranged in the claim." *In re Certain Floppy Disk Drives and Components Thereof*, 227 U.S.P.Q. 982, 985 (U.S. ITC 1985).

The reference discloses:

FIGS. 3-6 illustrate the GUI of remote 116 in the macro editing mode for recording on the VCR a TV program. The GUI shows a portion of a recorded macro with the following steps: "TV-on" (turn on the TV); "TV-3" (select channel 3); "Delay—0.5 sec" (wait for 0.5 seconds before issuing the next command); "VCR-on" (turn the VCR on); and "VCR-TV/VCR" (use the TV as source for the VCR). The GUI provides tools for editing the macro such as a scroll key 302, a delay key 304, arrow keys 306 and 308, and a delete key 310. Col. 4, lines 8-18.

These portions in the reference do not disclose a value currently representative of a different sound signal source or a preset value representative of a sound signal source of works to be performed on an electronic device.

Claims 9 and 10 call for "enabling a user of a controlled device to indicate a possible new value of a preset sound signal source and to separately confirm the indication and while the new value has been indicated and before the indication has been confirmed, changing the operation of another device in accordance with the indicated possible new value." The reference does not disclose the limitation of changing an operation of another device in accordance with the indicated possible new value. Thus claims 9 and 10 are separately patentable over the reference.

Regarding Claims 15 and 16, which were apparently inadvertently omitted from the first sentence rejecting claims 1-8, 12-14, the reference does not disclose "displaying values of possible selections of sound signal sources as called for by these claims. These claims do not broadly embrace displaying values of possible selections.

The reference discloses:

Preferably, the remote of the invention has the control options organized in a hierarchy of panels for individual display on the GUI. The user can program a macro that has one or more steps that lets the GUI jump to one or more specific ones of the panels during execution of the macro. Col 2, lines 5-19.

That is not a disclosure of "displaying values of possible selections of sound signal sources" called for by Claims 15 and 16. Thus claims 15 and 16 are separately patentable over the reference.

If this ground of rejection were repeated, the Examiner was respectfully requested to quote verbatim the language in the reference regarded as corresponding to each limitation in each of these rejected claims. The Examiner did not and cannot comply with this request.

II. CLAIM 11 MEETS THE CONDITIONS FOR PATENTABILITY UNDER SECTION 103(A), AT LEAST BECAUSE THE VAN EE PRIMARY AND SECONDARY REFERENCES FAILED TO SUGGEST THE DESIRABILITY OF COMBINING WHAT IS THERE DISCLOSED TO MEET THE LIMITATIONS OF THESE CLAIMS.

The final action states:

Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Van Ee et al. US Patent 6208341 in view of Sass US Patent Application 20050065625.

Regarding claim 11, Van Ee et al. teaches controlling a home entertainment system including an audio device (col. 2 lines 55-60) but is not explicit in teaching a radio station and the media player comprises a radio receiver. Sass in an art related audio system invention teaches a media player having a radio receiver (paragraph 008) and one skilled in the art recognizes that an audio system is associated with a radio station in order to receive broadcast information. P. 5.

Claim 11 is dependent upon and includes all the limitation of Claims 9 and 10, and the reasoning set forth above in support of the patentability of Claim 9 over the primary reference is submitted to support the patentability of Claim 11 so that further discussion of the secondary reference is submitted to be unnecessary. That the limitation of Claim 9 is absent from the primary reference makes it impossible to combine the primary and secondary references to meet the limitations of Claim 11. That is reason enough for withdrawing the rejection of Claim 11 on the primary and secondary references.

"Moreover, we observe that even if these references were combined in the manner proposed by the examiner, that which is set forth in appellant's claims . . . would not result." *Ex parte Bogar*, slip op. p.7 (BPA&I Appeal No. 87-2462, October 27, 1989). "Even if we were to agree with the examiner that it would have been obvious to combine the reference teachings in the manner proposed, the resulting package still would not comprise zipper closure material that

terminates short of the end of the one edge of the product containing area, as now claimed." *Ex parte Schwarz*, slip op. p.5 (BPA&I Appeal No. 92-2629 October 28, 1992). "Although we find nothing before us indicating why it would be desired to combine the references in the manner urged by the examiner, it is clear to us that such a modification by itself would not result in that which is set forth in the claims." *Ex Parte Kusko*, 215 U.S.P.Q. 972, 974 (BPA&I 1981).

"The mere fact that the prior art could be so modified would not have made the modification obvious unless the prior art suggested the desirability of the modification." *In re Gordon*, 221 U.S.P.Q. 1125, 1127 (Fed. Cir. 1984).

"The mere fact that the prior art could be so modified would not have made the modification obvious unless the prior art suggested the desirability of the modification." *In re Gordon*, 221 U.S.P.Q. 1125, 1127 (Fed. Cir. 1984).

"Although the Commissioner suggests that [the structure in the primary prior art reference] could readily be modified to form the [claimed] structure, '[t]he mere fact that the prior art could be so modified would not have made the modification obvious unless the prior art suggested the desirability of the modification.'" *In re Laskowski*, 10 U.S.P.Q. 2d 1397, 1398 (Fed. Cir. 1989).

"The claimed invention must be considered as a whole, and the question is whether there is something in the prior art as a whole to suggest the desirability, and thus the obviousness, of making the combination." *Lindemann Maschinenfabrik GMBH v. American Hoist & Derrick*, 221 U.S.P.Q. 481, 488 (Fed. Cir. 1984).

"Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination. Under Section 103, teachings of references can be combined *only* if there is some suggestion or incentive to do so." *ACS Hospital Systems, Inc. v. Montefiore Hospital*, 221 U.S.P.Q. 929, 933 (Fed. Cir. 1984) (emphasis in original, footnotes omitted).

"The critical inquiry is whether 'there is something in the prior art as a whole *to suggest* the desirability, and thus the obviousness, of making the combination. [citing *Lindemann* with emphasis added.]" *Fromson v. Advance Offset Plate, Inc.*, 225 U.S.P.Q. 26, 31 (Fed. Cir. 1985).

As the Federal Circuit Court of Appeals said in *In re Demblezak*, 175 F.3d 994, 999 (Fed. Cir.1999):

Close adherence to this methodology is especially important in the case of less technologically complex inventions, where the very ease with which the invention can be understood may prompt one 'to fall victim to the insidious effect of a hindsight syndrome wherein that which only the inventor taught is used against its teacher.'

CONCLUSION

In view of the foregoing authorities, reasoning and the inability of the prior art, alone or in combination, to anticipate, suggest or make obvious the subject matter as whole of the invention disclosed and claimed in this application, the decision of the Examiner finally rejecting claims 1-16 should be reversed. Should the Board be of the opinion that one or more of the rejected claims may be allowed in amended form, the Board is respectfully requested to include an explicit statement that a claim may be allowed in such amended form and direct that application owner should have the right to amend in conformity with such statement which shall be binding on the Examiner in the absence of new references or grounds of rejection.

The brief fee was previously enclosed. Please apply any other charges or credits to Deposit Account No. 06-1050, Order No. 02103-581001.

Respectfully submitted,
FISH & RICHARDSON P.C.

Date: September 25, 2006

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(vii) Claims Appendix

1. A method comprising providing, to a user of a control device, an indication of a value currently representative of a preset sound signal source, and simultaneously providing an indication of a possible new value of the preset representative of a different sound signal source.
2. The method of claim 1 in which the preset is associated with works performed by a multi-media system.
3. The method of claim 1 in which the multi-media system comprises an audio system.
4. The method of claim 1 in which the indications comprise graphical items on a display.
5. The method of claim 4 in which the display is part of the control device.
6. The method of claim 1 also including enabling a user to confirm the possible new preset value.
7. The method of claim 5 in which the control device communicates with a second device to effect the confirmed new preset value.
8. The method of claim 1 in which the value comprises an identifier of a station.
9. A method comprising enabling a user of a control device to indicate a possible new value of a preset sound signal source and to separately confirm the indication, and while the new value has been indicated and before the indication has been confirmed, changing an operation of another device in accordance with the indicated possible new value.
10. The method of claim 9 in which the value comprises an identifier of a station.
11. The method of claim 10 in which the station comprises a radio station and the another device comprises a radio receiver.

12. The method of claim 1 in which the sound signal source comprises a source of items to be performed, the source being configured to store the items for performance in response to the preset.
13. A method comprising providing to a user of a control device, an indication of values of recently invoked presets, each of the preset values being representative of a sound signal source of works to be performed on an electronic device, different ones of the preset values being associated with different sources.
14. The method of claim 13 also including enabling the user to identify one of the presets, and causing an electronic device to change its state in response to the identification of the preset.
15. A method comprising displaying values of possible selections of sound signal sources at one level of a hierarchy of values, enabling a user to select one of the values at the one level of the hierarchy, and while at least a portion of the one level of the hierarchy is displayed, showing possible selections at a second, lower level of the hierarchy that correspond to the one of the values selected by the user, at least other portion of the one level being obscured.
16. The method of claim 15 further comprising displaying an identification of the level of the hierarchy currently displayed.